

REMARKS

Reconsideration and reexamination of the present application are respectfully requested in light of the foregoing amendments and following remarks.

1. Status of the Claims

Claims 11-12, 14-16, and 19 stand pending. Claims 1-10, 13, 17-18, and 20-21 are canceled. Claims 11-12, 14-16, and 19 stand rejected.

2. Withdrawn Rejections

Applicants appreciate the indication that the rejections previously of record are withdrawn.

3. Rejection under the Judicially Created Doctrine of Obviousness-Type Double Patenting

Claims 11, 12, 14-16 and 19 are newly rejected on the ground of obviousness-type double patenting over claims 1-7 of U.S. Patent No. 6,706,734 ("the '734 patent"). Applicants traverse the rejection.

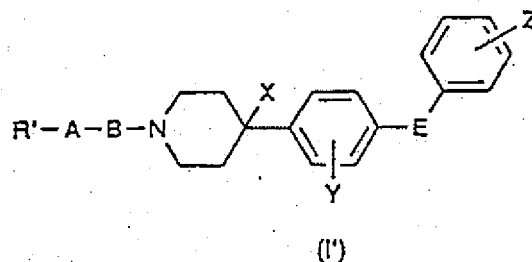
The doctrine of double patenting is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinguishing from claims in a first patent. *See* MPEP § 810, "Definition of double patenting." It is well established that it is the *claims* that are at issue in a double patenting rejection, not the respective disclosures of the patent and application. When considering whether the invention defined in a claim of an application would have been an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1279, 23 U.S.P.Q.2d 1839, 1846 (Fed. Cir. 1992).

Whether the present claims are obvious in view of the '734 patent claims must be determined by an analysis consistent with *Graham v. John Deere Co.*, 383 U.S. 1, 15-17 (1966); *see also* MPEP § 804. "[The] test for *prima facie* obviousness for chemical compounds is consistent with the legal principles enunciated in *KSR*." *Takeda Chem. Indus. Ltd. v. Alphapharm Pty. Ltd.*, 83 U.S.P.Q.2d 1169, 1174 (Fed. Cir. 2007). The Federal Circuit states the appropriate test: "structural similarity between claimed and prior art subject

matter, proved by combining references or otherwise, where the prior art gives reason or motivation to make the claimed compositions, creates a *prima facie* case of obviousness." *In re Dillon*, 919 F.2d 688, 16 U.S.P.Q.2d 1897, *en banc* (Fed. Cir. 1990). That is, in addition to structural similarity between the compounds, a *prima facie* case of obviousness also requires a showing of adequate support in the prior art for the change in structure. *In re Grabiak*, 769 F.2d 729, 731-32 (Fed. Cir. 1985) (reversing the Board, where the prior art provided no suggestion to substitute a sulfur atom for an oxygen atom). The prior art must suggest the specific molecular modifications necessary to achieve the claimed invention. *Takeda*, 83 U.S.P.Q.2d at 1174 (citing cases).

In the present case, the *Graham* analysis should be based on an objective analysis of the scope and content of the '734 patent claims, the differences between the '734 patent claims and the present claims, and the level of skill in the pertinent art. *See, e.g.*, MPEP § 804. The disclosure of Compound 46 in the '734 patent specification is irrelevant to this inquiry. *See General Foods*, 23 U.S.P.Q.2d at 1846.

The claims in the '734 patent are directed in part to a compound having the formula (I'), wherein E is a *connecting bond or a methylene group* ('734 patent, col. 53, lines 17-18):



By contrast, the presently claimed invention is directed in part to a compound of the same general formula (I'), wherein E is an *oxygen atom*. *See* Claim 1, line 16. The Office provides no evidence or reasoning that the prior art suggests the specific molecular modifications necessary to achieve the presently claimed invention. *See, e.g., Grabiak*, 769 F.2d at 731-32. For these reasons, the Office has failed to make a *prima facie* case that the present claims would have been obvious in view of claims 1-7 of the '734 patent. The rejection accordingly should be withdrawn.

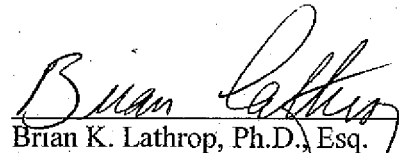
CONCLUSION

In conclusion, this is believed to be in full response to the Office Action. Should any issues remain outstanding or if there are any questions concerning this paper, or the application in general, the Examiner is invited to telephone the undersigned representative at the Examiner's earliest convenience. Should any outstanding fees be owed or overpayments credited, the Commissioner is invited to respectively charge or credit Deposit Account No. 50-0573. The Office is authorized to charge the Deposit Account for Notice of Appeal, if said Notice of Appeal is necessary in order to maintain pendency of the application.

Respectfully submitted,

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